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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,598	11/14/2003	Carol Rudolph	4000335-148192	2011
23570	7590	12/21/2005	EXAMINER	
PORTER WRIGHT MORRIS & ARTHUR, LLP			HAYES, BRET C	
INTELLECTUAL PROPERTY GROUP			ART UNIT	PAPER NUMBER
41 SOUTH HIGH STREET				3641
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COLUMBUS, OH 43215			DATE MAILED: 12/21/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/713,598	RUDOLPH, CAROL
	Examiner	Art Unit
	Bret C. Hayes	3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 and 10-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All . b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1 – 3, 10, 11, 15 – 19 and 21 – 24 are rejected under 35 U.S.C. 103(a) as obvious over US Patent No. 4,352,340 to Strubelt.
3. Re – claims 1 and 15, Strubelt discloses the claimed invention including a one-piece litter box **A** comprising an apparently hexangular or octangular container **10**, best seen in Fig. 1, for example, have a base wall **20** with side walls **22** forming an apparently hexangularly or octangularly-shaped hollow interior space, a top opening, best seen in FIG. 2, for example, formed by upper edges of the sidewalls **22**, an entrance opening **24** formed in one of the sidewalls **22**, the opening **24** being circular and having a diameter in the range of about eight inches to about 10 inches {at col. 1, line 66, (1:66) Strubelt discloses “approximately three (3) inches of litter material”, which, from FIG. 2, measures just over 1 cm; the opening **24** in the same FIG. measures a full three (3) times that, which means that the opening **24** measures ≈9 inches (3 X 3 in.) in diameter, which meets the claimed limitation of about 8 to about 10 inches}, the opening **24** being sized and positioned to permit passage of the animal therethrough but substantially avoid escape of urine, feces and litter therethrough, the opening **24** being spaced below the top opening and, using the measurements from before, spaced at least 6 in. from the base wall **20** (see further explanation below), the opening being spaced above a bottom of the

container a distance equal to at least forty percent of the height of the container (see further explanation below), the sidewalls 22 being free of any openings other than opening 24, the opening 24 being free of any coverings, and the sidewalls 22 form a height of the container 10 which substantially prevents the animal from seeing over the sidewalls 22.

4. Further, re – claims 1 and 15, it has been held that the recitation that an element is “capable of” perform a function – “the animal can see”, for example, (*emphasis added*) is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. In this case, provided that the animal is of an appropriate size, the animal could see as claimed.

5. Additionally, it is noted that the claims are directed to an apparatus *per se*, not a method of operation.

However, the claims contain limitations concerning the method/manner of the animal entering, turning, facing, and exiting.

Note that it is well settled case law that such limitations, which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235; *In re Otto*, 136 USPQ 458; and, *Ex parte Masham*, 2 USPQ2nd 1647.

See MPEP 2114, which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim, *Ex parte Masham*, 2 USPQ2nd 1647; Claims directed to apparatus must be distinguished from the prior art in terms of the structure rather than functions, *In re Danly*, 120 USPQ

528, 531; and, Apparatus claims cover what a device is, not what a device does, *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

6. Also, while patent drawings are not necessarily drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of the claims. See *In re Mraz*, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

7. Strubelt does not explicitly state the opening **24** being at least 6 in. from the base wall **20**. However, measuring as before from the bottom of the base wall **20** to the bottom of the opening **24**, it would appear that the distance is nearly 6 in., and the difference between nearly 6 in. and at least 6 in. in the realm of litter boxes would be obvious to one of ordinary skill in the art at the time the invention was made, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

8. Strubelt discloses the center of the entrance opening **24** being spaced above a bottom of the container **10** a distance of roughly 25 percent of the height of the container **10**. Since no showing of criticality of this dimension, other than functional recitations, has been given, it would be obvious to one of ordinary skill in the art at the time the invention was made to space the opening **24** as any percentage of the overall height of the container as a function of the overall height of the container. In other words, despite any argument to the contrary and lacking any evidence to the contrary, it would not matter to a cat how tall the container was, rather the height and diameter of the opening allowing entrance. Further, Strubelt does not explicitly disclose the opening **24** being spaced above a bottom of the container **10** a distance equal to at least forty percent of the height of the container **10**. However, Strubelt appears to show the opening being within that range, therefore, this claimed limitation has been met.

9. Strubelt discloses the claimed invention except for the container 10 being rectangular. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a rectangular container for the hexangular/octangular, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23. In this case, while the container as disclosed by Strubelt appears to be circular at least at the top, it also appears to have flattened 'sides' (at least 6, possibly 8), which would inherently include the arguably preferred-to-be-used-by-cats corners. For one of ordinary skill in the art at the time the invention was made to change this shape from at least 6 (and possibly 8) corners down to only four corners would not require an enormous inventive leap.

10. Further, while the term 'rectangular' does not exclude the possibility of a square, it is most often associated with four sided polygons where two parallel sides are longer than the other two parallel sides. With that in mind, the claimed limitation is inherent in the shape. Regarding the location of the door being on one of the longer sidewalls, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the door on one of the longer sidewalls, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. In this case, aside from aesthetics, a cat is not going to give much thought to where a door is located and the litter box functions the same.

11. Alternatively, Claims 1 – 3, 10, 11, 15 – 19 and 21 – 24 are rejected under 35 U.S.C. 103(a) as obvious over Strubelt in view of European Patent Application 0 372 659 A1 to Goemans.

12. Re – claims 1 and 15, Strubelt discloses the invention as claimed above except for the container **10** being rectangular. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the container in the shape of a rectangle for economical reasons as such is conventional in the art as shown by Goemans because a rectangular structure would be more economical to produce than the more elaborate structure as shown in Fig. 1 of Strubelt.

13. Further, Strubelt discloses the center of the entrance opening **24** being spaced above a bottom of the container **10** a distance of roughly 25 percent of the height of the container **10**, except for the entrance opening being spaced above a bottom of the container a distance equal to at least forty percent of the height of the container. Goemans teaches an entrance opening being spaced above a bottom of the container a distance equal to at least forty percent of the height of the container, as best seen in Figs. 1 and 2, for example, in the same field of endeavor for the purpose of preventing cat litter pellets and/or excrements of a cat from being deposited beside the litter box, see co.. 1, lines 2 – 9, for example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Strubelt to include the entrance opening being spaced above a bottom of the container a distance equal to at least forty percent of the height of the container as taught by Goemans in order to aid in retaining litter materials.

14. Re – the location of the door, as applied above, the rearrangement of parts of the device.

15. Re – claims 2 and 16, Strubelt discloses the sidewalls **22** being continuous except for the entrance opening **24**.

16. Re – claim 3, since Strubelt discloses at least 6 in. to the bottom of the opening **24** and ≈ 9 in. for the diameter, then from FIG. 2, it is clear that the height of the container **10** is at least 15

in. (6 + 9 = 15). However, Strubelt does not explicitly disclose the height of the container being about 15 in. It would have been an obvious matter of design choice to change the size of the container to be about 15 in., since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

17. Alternatively, Goemans teaches a litter box having a height of at least 35 cm, which is equivalent to 13.8 inches, which is about 15 inches, in the same field of endeavor for the purpose of retaining litter and/or excrement materials. It would be obvious to one of ordinary skill in the art at the time the invention was made to modify Strubelt to have the height if the container be about 15 inches as taught by Goemans in order to retain litter and/or excrement materials.

18. Re – claims 10 and 18, since the lid 12 disclosed by Strubelt is removable, it is not part of the structure of the container 10, itself, and therefore, the top opening is entirely open and free of any covering, as shown in Fig. 2, for example.

19. Re – claims 11 and 19, from FIG. 1, it appears that the container 10 is opaque. However, Strubelt does not explicitly state that the container is made from a plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the container from a plastic material, since it has been held to be within the general skill of a

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. This is further evidenced by the fact that one would experience great difficulty attempting to find a litter box made of anything other than a plastic material today.

20. Re – claims 21 and 23, Strubelt discloses an interior surface being seamless, interfaces between sidewalls being rounded, and interfaces between the base wall and the sidewalls being rounded, as best seen in FIG. 2, for example.

21. Re – claims 22 and 24, while Strubelt discloses disposing a liner on which to place litter, the recitation of a new intended use for an old product does not make a claim to an old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In this case, the device itself is to be used as a litter box for felines, and one of ordinary skill in the art at the time the invention was made would require no further impetus than either a shortage of liners or a cost prohibitive supply of liners to hit upon the idea of using the device without a liner. In fact, most commercially available litter boxes are designed to be used without liners.

22. Claims 12 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Strubelt in view of US Patent No. 6,196,156 B1 to Denesuk et al.

23. Strubelt discloses the invention substantially as claimed as applied above. However, Strubelt does not disclose wherein the container is molded of a plastic material including an antimicrobial material. Denesuk et al. teach an article 114 molded of a plastic material including an antimicrobial material, 4:40 – 5:55 in the same field of endeavor for the purpose of inhibiting microbes in domestic animal bedding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strubelt to include the container being

molded of a plastic material including an antimicrobial material as taught by Denesuk et al. in order to inhibit microbes.

24. Claims 13 and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Strubelt in view of US Patent No. Des. 380,880 to Reid.

25. Re – claim 13, Strubelt discloses the invention substantially as claimed as applied above. However, Strubelt does not disclose wherein the upper edges of the sidewalls form a lip having a round upward-facing surface. Reid teaches upper edges of sidewalls forming a lip having a round upward-facing surface in the same field of endeavor for the purpose of handling the litter box. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strubelt to include the upper edges of sidewalls forming a lip having a round upward-facing surface as taught by Reid in order to handle the litter box.

26. Re – claim 14, Strubelt discloses the invention substantially as claimed as applied above. However, Strubelt does not disclose wherein the upper edges of the sidewalls form a lip having a width of no more than one-half inch. Reid teaches the upper edges of the sidewalls forming a lip having a width of substantially no more than one-half inch in the same field of endeavor for the purpose of strengthening the structure of the litter box. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strubelt to include the upper edges of sidewalls forming a lip having a width of no more than one-half inch as taught by Reid in order to strengthen the structure of the litter box.

Response to Arguments

27. Applicant's arguments with respect to claims 1 – 3 and 10 – 26 have been considered but are moot in view of the new ground(s) of rejection.

Response to Amendment

28. The declaration under 37 CFR 1.132 filed 07 OCT 05 is insufficient to overcome the rejection of claims 1 – 3 and 10 – 24 based upon the above cited references as set forth in this Office action because: Strubelt clearly discloses that a cat will tend to face the opening as in Fig. 2, for example; it is merely Applicant's assertion that cats face away from sharp corners; and, Goemans teaches centering a door, and, to center a door is done just as well for aesthetic (non-functional) reasons.

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov. The examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

bh

19-Dec-05

MICHAEL J. CARONE
MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER